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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,495	07/02/2003	Tienteh Chen	200209928-1	4418

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EXAMINER

SCHWARTZ, PAMELA R

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/613,495

Applicant(s)

CHEN ET AL.

Examiner

Pamela R. Schwartz

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005 and 24 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 9-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (2003/0186003) for reasons of record and for reasons given below.
2. Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (2003/0186003) as applied to claim 1, 3 and 4 above, and further in view of Shih et al. (6,780,924) or applicants' admissions at [0014] of the specification for reasons of record and for reasons given below.
3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakano et al. (2003/0186003) as applied to claims 1-8 above, and further in view of Kaneko et al. (US2001/0004487) for reasons of record and for reasons given above.
4. Claims 1-8 rejected under 35 U.S.C. 103(a) as being unpatentable over applicants' admissions in their 131 Declaration. The papers filed by applicants admit that both the base paper and the ink receptive coating of their invention were known at the time of their invention. Based upon this admission, it would have been obvious to one of ordinary skill in the art to coat the commercially available base paper with a known ink receptive composition at a conventional coating weight in order to obtain an ink receptive medium.
5. Applicant's arguments filed June 27, 2005 and August 24, 2005 have been fully considered but they are not persuasive. The examiner has considered applicants' 131 Declaration. With respect to the Declaration, while applicants state in their specification a smoothness and porosity for the tradenamed base sheet, there is nothing to indicate the smoothness and porosity of the tradenamed base sheet at the time of creation of the submitted invention disclosure and graph (exhibits A and B with the Declaration).

The submitted exhibits do not mention either of these properties and since the properties of tradenamed materials may change over time, applicants may not rely on the recitation of properties set forth in their specification unless they can demonstrate that the properties of the material were the same at the time of the creation of their exhibits.

Additionally, applicants' admissions that both the base paper and coating are conventional obviate the invention. It would have been obvious to one of ordinary skill in the art to coat a known base paper with an ink receptive coating to render the paper ink receptive and to determine the minimum coat weight required to absorb ink solvent. It is also noted that applicants' coating weight is within the range conventionally used in the art. This is a well known parameter that is obvious to optimize, normally so that the minimum required coating is applied to yield desired printing characteristics.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
November 26, 2005



PAMELA F. SCHWARTZ
PRIMARY EXAMINER